

REMARKS

1. Summary of the Office Action

In the Office Action mailed February 13, 2009, the Examiner rejected claims 1-14 under 35 U.S.C. § 103(a) as being unpatentable over United States Patent Pub. No. 2006/0058010 (Williams) in view of United States Patent Pub. No. 2002/0068546 (Plush).

2. Status of the Claims

Applicant has herein amended claims 1-14 and added new claims 15-18. Currently pending are claims 1-18, of which claims 1 and 8 are independent, and the remaining pending claims dependent.

3. Response to the Office Action with Respect to the Examiner's Rejections under 35 U.S.C. § 103

As noted above, the Examiner rejected claims 1-14 under 35 U.S.C. § 103(a) as being obvious over Williams in view of Plush.

In order to assert a prima facie case of obviousness under 35 U.S.C. § 103, the Examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a prima facie case of obviousness) is more probable than not. *MPEP §2142 rev. 6* (October 2007).

KSR International Co. v. Teleflex Inc. requires that an Examiner provide "some articulated reasoning with some rationale underpinning to support the legal conclusion of

obviousness." *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, ___, 82 USPQ2d 1385, 1396 (2007). An Examiner must "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does," *Id.* The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art. *Id.* The Examiner must make "explicit" this rationale of "the apparent reason to combine the known elements in the fashion claimed," including a detailed explanation of "the effects of demands known to the design community or present in the marketplace" and "the background knowledge possessed by a person having ordinary skill in the art." *Id.* at 1389. The rationale must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *Id.* at 1397. Anything less is not sufficient to sustain a prima facie case of obviousness. *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329 (Fed. Cir. 2006). Based upon *KSR* and *MPEP* § 2142, the Examiner has failed to establish a prima facie case of obviousness, and therefore the Examiner's rejection should be withdrawn.

- a. **The Examiner has failed to assert evidence establishing obviousness of the claim limitation requiring storage of "identifiers identifying at least two types of telecommunication services, a first identifier identifying a first type of telecommunication services that decrease the account value when used by any one or more group members, and a second identifier identifying a second type of telecommunication services that increase the account value when used by any one or more group members."**

The Examiner, in making the determination of obviousness, exclusively relied upon the Williams reference for the above-noted limitation. Specifically, the Examiner cited to paragraphs [0061] and [0064] as disclosing this limitation. However, paragraphs [0061] and [0064] of Williams merely disclose a Service Data Function (SDF) 20 that is

responsible for “storing data relating to prepaid subscribers...instance data relating to services currently being provided to a prepaid subscriber, and..., personalized rating information for a subscriber.” (See paragraph [0061]). Neither paragraph discloses the storage of identifiers that identify at least two types of telecommunications services, wherein the use of an identified first type by a user causes a stored account balance to increase, and wherein the use of an identified second type causes a stored account balance to decrease. At most, paragraphs [0061] and [0064] disclose the storing and maintaining of an account balance that may only decrease in light of a user’s continued use of the provider’s communications systems.

Accordingly, because the Williams reference, exclusively relied upon by the Examiner for disclosing the above-referenced limitation, fails to actually disclose the limitation, Applicant submits that the Examiner has failed to raise a prima facie case of obviousness, and respectfully request that the rejection be withdrawn and all claims allowed to issue.

- b. The Examiner has failed to assert evidence establishing obviousness of the claim limitation requiring storage of “a rule-set for mapping each unit of a telecommunications service used by any one or more group members to a corresponding account value change unit for increasing or decreasing the account value based on the type of telecommunication service.”**

The Examiner, in making the determination of obviousness, exclusively relied upon the Williams reference for the above-noted limitation. Specifically, the Examiner cited to paragraphs [0061] and [0064] as disclosing this limitation. However, paragraphs [0061] and [0064] of Williams merely discloses an overriding rate that overrides a normally applicable rate class. The disclosure of an overriding rate that replaces a

general rate fails to read on the storage of a rule-set that maps each unit of a telecommunications service to a corresponding account value change unit.

Accordingly, because the Williams reference, exclusively relied upon by the Examiner for disclosing the above-referenced limitation, fails to actually disclose the limitation, Applicant submits that the Examiner has failed to raise a prima facie case of obviousness, and respectfully request that the rejection be withdrawn and all claims allowed to issue.

- c. The Examiner has failed to assert evidence establishing obviousness of the claim limitation requiring a data part that stores an “account value indicating which of one or more tariff rates is to be applied to a communications service used by a subscriber,” a Rating part that calculates “a new account value” responsive to detected “usage of a telecommunication service by any one or more of the group members,” and re-storing “the new account value” in the data part.**

The Examiner, in making the determination of obviousness, exclusively relied upon the Williams reference for the above-noted limitation. Specifically, the Examiner cited to paragraphs [0061], [0064], and [0068]-[0071] as disclosing this limitation. However, paragraphs [0061] and [0064] of Williams merely disclose the storage of an account balance and an overriding rate class. (See paragraphs [0061] and [0064]). And paragraphs [0068]-[0071] merely disclose the calculation of a time period between which a user's account should be charged for service usage. Neither paragraph discloses the storage of an account value indicating a tariff rate that changes as a result of a usage of a telecommunication service by any one or more of the group members, and the re-storage of a modified account value as a result of that usage. In applicant's invention the account value represents a tariff, but is not the actual tariff itself or remaining prepaid funds

available. In fact, the actual translation from account value to tariff may be different for each service in Applicant's method and device.

As set forth in the amended claims, the "account value" of applicant's invention is used to determine an applicable rate for a service. The "account balance" of Williams represents no tariff or rate, but merely a monetary amount that may be spent via use of telecommunications services.

This difference may be easily understood when considering the effect of a zero balance (or account value). If Applicant's account value was put to zero, chargeable services may still be delivered to a subscriber, whereas if a prepaid balance was put to zero, in the Williams teaching a chargeable service would simply no longer be delivered.

Accordingly, because the Williams reference, exclusively relied upon by the Examiner for disclosing the above-referenced limitation, fails to actually disclose the limitation, Applicant submits that the Examiner has failed to raise a prima facie case of obviousness, and respectfully request that the rejection be withdrawn and all claims allowed to issue.

4. Conclusion

In light of the forgoing, Applicant submits that all claims are now in condition for allowance. Should the Examiner wish to discuss this case with the undersigned, the Examiner is invited to call the undersigned at (312) 913-0001.

Respectfully submitted,

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